2009-1400

(Serial No. 09/725,737)

In The

United States Court of Appeals

For The Federal Circuit

2009 SEP 10 PM
US COURT OF
FEDERAL CIRCUIT

IN RE PETER JOSEPH GIACOMINI, WALTER MICHAEL PITIO, HECTOR FRANCISCO RODRIGUEZ, and DONALD DAVID SHUGARD

APPEAL FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE, BOARD OF PATENT APPEALS AND INTERFERENCES.

BRIEF OF APPELLANTS

Jason P. DeMont
Robert L. Greenberg
DeMont & Breyer LLC
100 Commons Way, Suite 250
Holmdel, New Jersey 07733
(732) 687-7990

Counsel for Appellants

Dated: September 10, 2009

THE LEX GROUP^{DC} ♦ 1750 K Street, N.W. ♦ Suite 475 ♦ Washington, D.C. 20006
(202) 955-0001 ♦ (800) 815-3791 ♦ Fax: (202) 955-0022 ♦ www.thelexgroupdc.com

CERTIFICATE OF INTEREST

In accordance with Fed. Cir. Rule 47.4 and Fed. R. App. P. 26.1, counsel certifies the following:

1. The full name of every party or amicus represented by me is:

   Broadspider Networks, Inc.

2. The real party in interest represented by me is the assignee of this patent application — Broadspider Networks, Inc. The partners in the law firm that represents Broadspider Networks, Inc. — Jason Paul DeMont & Wayne S. Breyer — are shareholders in Broadspider Networks, Inc. and have a financial interest the patent application under appeal.

3. All parent corporations and any publicly held companies that own ten percent or more of the stock of the parties represented by us are:

   None.

4. The names of the law firms and the partners that have appeared in the lower tribunal and are expected to appear in this Court are: Jason Paul DeMont and Wayne S. Breyer of DeMont & Breyer, LLC.

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Jason P. DeMont

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STATEMENT OF RELATED CASES

No other appeal from this application has previously been before this or any other appellate court. Counsel knows of no case pending in this or any other court that will directly affect or be directly affected by this Court's decision in this appeal.

JURISDICTIONAL STATEMENT

This case is an appeal from a final decision of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office, and, therefore, this Court has jurisdiction under 28 U.S.C § 1295(a) and 35 U.S.C. § 141.

STATEMENT OF THE ISSUES

The appellants filed a 35 U.S.C. § 111(a) non-provisional patent application with the United States Patent and Trademark Office that contained the appealed claims. In searching for prior art, the Patent Office discovered V. Tran et al., U.S. Patent 7,039,683 B1. Although the Patent Office believed that Tran's patent taught the claimed invention, it was not useable as a reference because its 35 U.S.C. § 102(e) filing date is after the priority date of the appealed claims.

The Patent Office noticed, however, that Tran's patent contained a 35 U.S.C. § 119(e) priority claim to a 35 U.S.C. § 111(b) provisional that was filed before the priority date of the appealed claims. In an attempt to legitimize the use of Tran's patent as prior art against the appealed claims, the Board of Patent Appeals and Interferences held that the 35 U.S.C. § 119(e) priority claim in Tran's patent shifted the effective reference date of Tran's patent to the effective reference date of Tran's provisional.

Issue #1 — Did the Board of Patent Appeals and Interferences err in holding that the 35 U.S.C. § 119(e) priority claim in Tran's

patent shifted the effective reference date of Tran's patent to the effective reference date of Tran's provisional?

This is a question of law and an issue of first impression. The appellants seek a holding that a 35 U.S.C. § 119(e) priority claim in a patent does not shift the effective reference date of a U.S. patent to the effective reference date of the provisional. This would remove Tran's patent as prior art against the appealed claims and require reversal of the Board of Appeals.

By holding that the effective reference date of Tran's patent was shifted to the effective reference date of Tran's provisional, the Board of Appeals was only halfway to its goal. The Board of Appeals had not yet established that the effective reference date of Tran's patent was before the priority date of the appealed claims — only that the effective reference date of Tran's patent was shifted to the effective reference date of Tran's provisional. The Board of Appeals still needed to ascertain the effective reference date of Tran's provisional. If the effective reference date of Tran's provisional was governed by 35 U.S.C. § 102(a)/(b), its effective reference date would be after the priority date of the appealed claims. This would cause the effective reference date of Tran's patent to be after the priority date of the appealed claims and prevent it from being useable as prior art.

In contrast, if the effective reference date of Tran's provisional was governed by 35 U.S.C. § 102(e), its effective reference date and, therefore, the effective reference date of Tran's patent would be before the priority date of the appealed claims. This would make Tran's patent prior art against the appealed claims. Therefore, the Board of Appeals held that the effective reference date of Tran's provisional is governed by 35 U.S.C. § 102(e) and is its filing date.

> **Issue #2** — Did the Board of Patent Appeals and Interferences err in holding that the effective reference date of Tran's provisional is governed by 35 U.S.C. § 102(e) and is its filing date?
>
> This a question of law and an issue of first impression. The appellants seek a holding that the effective reference date of a 35 U.S.C. § 111(b) provisional is not governed by 35 U.S.C. § 102(e) and is not its filing date. This would remove Tran's patent as prior art against the appealed claims and require reversal of the Board of Appeals.

Finally, the Patent Office also rejected the appealed claims for being anticipated by D. Teoman et al., U.S. Patent 6,463,509 B1.

> **Issue #3** — Did the Board of Patent Appeals and Interference err in affirming that D. Teoman et al., U.S. Patent 6,463,509 B1 anticipates the appealed claims?

This is a question of fact. The appellants seek a holding that Teoman's patent does not anticipate the appealed claims.

STATEMENT OF THE CASE

The appellants filed a 35 U.S.C. § 111(a) non-provisional patent application with the United States Patent and Trademark Office that contained the appealed claims. The appealed claims were finally rejected, and the appellants took an appeal to the Board of Patent Appeals and Interferences. The Board of Appeals reversed some of the rejections, but affirmed the rejections being appealed to this Court.

STATEMENT OF THE FACTS

Because most people are familiar with the World Wide Web, the invention shall be described in that context, but the invention is equally applicable to data processing systems and computer networks.

When a user of the World Wide Web requests a Web page, the user must wait until the page is available on his or her computer for viewing. In general, this wait occurs because the request for the Web page must travel from the user's computer to the Web server that has the page, the Web server must fulfill the request, and the requested page must travel back to the user's system. Often the round trip comprises many switches, routers, and gateways and each adds a delay to the trip.

If the Internet is congested or the Web server is overwhelmed with requests, the wait can be considerably long. To shorten this wait, auxiliary Web servers are deployed throughout the World that store a copy of the Web page. Thereafter, one of the auxiliary Web servers intercepts and fulfills each request for the Web page.

The auxiliary Web server expedites the delivery of Web pages in two ways. First, there are fewer switches, routers, and gateways between the user's computer and the auxiliary Web server, and, therefore, the round trip to the auxiliary Web server and back is faster. Second, when the global burden of fulfilling all of the Web page requests is shared by a number of auxiliary Web servers, the burden on each is less than the total and the responsiveness of each is faster than if one server that had to fulfill the requests alone.

Although the auxiliary Web server exists, the request for the Web page is directed to the original Web server and not to the auxiliary Web server. For all intents and purposes, the fulfillment of the request by the auxiliary Web server appears — to the user's computer — to be performed by the Web server that is the original source of the Web page. The auxiliary Web server is — to the user's computer — totally invisible. The technical name for an invisible repository like the auxiliary Web server is a "cache."

A cache comprises physical memory, and, therefore, it has a finite capacity. Because the cache has a finite capacity, there is not enough room for every resource (*e.g.*, Web page, *etc*.) to be stored in it. And because there is not enough room for every resource to be stored in it, it should only contain those resources that are actually requested.

If a resource is requested and it is not stored in the cache, then the cache is not helpful. If a resource is stored in the cache, but is not requested, the resource is taking up room in the cache that could be used for resources that are requested.

Therefore, the usefulness of the cache depends on intelligently deciding:

i. which resources are stored in the cache and when, and

ii. which resources are discarded from the cache to make room for other resources and when.

The present invention pertains to the first part — deciding which resources are stored in the cache and when.

There are two classes of techniques in the prior art for determining when a resource is stored in a cache. Each will be briefly described to provide context for the present invention and then the present invention will be described.

Prior Art Technique #1 — "Pre-Filling"— if a resource is stored in a cache before a request for the resource has been received, then the cache employs "pre-filling." This is prior art, and it is also commonly known as "pre-loading."

When a pre-filling technique is good, it is beneficial because it stores a resource in the cache before it is ever requested.

Pre-filling might sound as if it relies on clairvoyance, but typically it is based on a natural association of two or more resources in a set. For example, salt and pepper are naturally associated with each other, and when a request for salt is made, it is reasonable to assume that a request for pepper might occur in the near future. Have you ever had a dinner guest in your home ask for salt and you instinctively handed them both the salt shaker and the pepper mill?

A Web server might comprise thirty Web pages — one for each of the thirty Major League Baseball teams. If a request is received for the Baltimore Orioles Web page and then a request is received for the Boston Red Sox Web page, it is reasonable to predict that requests for the other twenty-eight other Web pages might arrive in the future. In other words, when a threshold number of requests for the individual resources in a set of associated resources have been received, it is reasonable to predict that requests for the other resources in the set might arrive in the future.

Therefore, if the threshold number is two, then two requests — the request for the Baltimore Orioles Web page and the request for the Boston Red Sox Web page — will trigger the storage of all thirty Web pages in the cache — even though no requests for twenty-eight of them have yet been received. The twenty-eight

Web pages that were stored in the cache before they were ever requested are examples of classic prior art pre-filling.

Prior Art Technique #2 — "Post-Filling" — if a resource is — or can be — stored in a cache after only one request has been received for that resource, then the cache employs "post-filling." This is prior art.

Continuing with the example from pre-filling, the Baltimore Orioles Web page is stored in the cache after there has been a request for it.. This is classic post-filling. Similarly, the Boston Red Sox Web page is stored in the cache after there has been a request for it. This is also classic prior art post-filling.

The Invention — "Delayed Post-Filling" — if there are occasions when a resource is prevented from being stored in the cache until two or more requests for the resource have arrived, then the cache employs "delayed post-filling." This is a general, but reasonable, description of the appellant's invention for the purposes of this appeal. An advantage of the present invention is that it prevents — during the occasions when it is employed — the cache from being populated with a resource that is only requested once.

The present invention is an important invention in data processing systems and computer networks and has been widely adopted.

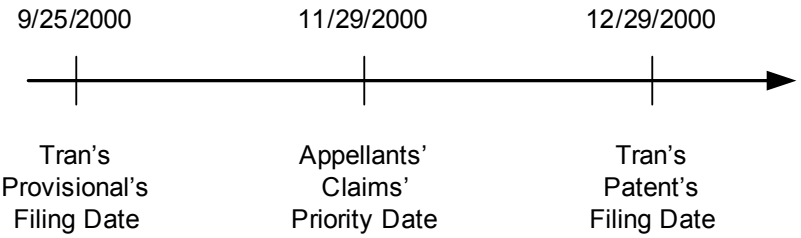
Claims 1, 8, 11, 12, 15, 22-24, 27-28, 31-32 (hereinafter "the appealed claims") have been rejected under 35 U.S.C. § 102(e) as being anticipated by two references:

1. V. Tran et al., U.S. Patent 7,039,683 B1 (hereinafter "Tran's patent"), and
2. D. Teoman et al., U.S. Patent 6,463,509 B1 (hereinafter "Teoman").

The Board of Patent Appeals and Interferences has affirmed the rejections, and the appellants have brought this appeal.

Tran Rejection — The Tran rejection hinges solely on whether Tran's patent is prior art against appealed claims or not. The Board of Patent Appeals and Interferences acknowledged that Tran's patent is not a 35 U.S.C. § 102 reference because its filing date is after the priority date of the appealed claims.

The Board of Appeals, however, noted that Tran's patent claimed priority under 35 U.S.C. § 119(e) to a provisional that was filed before the priority date of the appealed claims.



This, the Board of Appeals reasoned, provided the basis for shifting the effective reference date of Tran's patent to the filing date of Tran's provisional.

Relying on *Ex Parte Yamaguchi*, 88 USPQ2d 1606 (BPAI 2008) (precedential), the Board of Patent Appeals and Interferences held that the § 119(e) priority claim in Tran's patent shifted the effective reference date of Tran's patent to the effective reference date of Tran's provisional.

This, however, merely shifted the effective reference date of Tran's patent to the effective reference date of Tran's provisional. It did not establish the effective reference date of Tran's provisional as the filing date of Tran's provisional. To accomplish this, the Board of Appeals again relied on *Yamaguchi* to hold that the effective reference date of a § 111(b) provisional is governed by § 102(e), and is, therefore, its filing date. In summary, the links in the chain of the Board of Appeals' reasoning is:

- the effective reference date of Tran's patent is the effective reference date of Tran's provisional,
- the effective reference date of Tran's provisional is the filing date of Tran's provisional, and
- the filing date of Tran's provisional is before the priority date of the appealed claims,

therefore

- the effective reference date of Tran's patent is before the priority date of the appealed claims, and

- Tran's patent is prior art against the appealed claims.

The appellants respectfully submit that this chain of reasoning incorrect. First, the effective reference date of Tran's patent is not the effective reference date of Tran's provisional. Second, the effective reference date of Tran's provisional is not its filing date. Because *Yamaguchi* is the authority for both propositions, the appellants respectfully submit that *Yamaguchi* should be overturned. If this Court holds that either holding of the Board of Appeals is incorrect, then Tran's patent is not prior art against the appealed claims and the rejection should be reversed.

Teoman Rejection — The Board of Patent Appeals and Interferences affirmed the rejection of the appealed claims based on a logical error. There is no dispute about what the reference explicitly teaches, only what the logical consequences are of that teaching. Because this logical error is clearly erroneous, the appellants respectfully submit that the rejection based on Teoman should be reversed.

SUMMARY OF THE ARGUMENT

I. Tran's Patent is Not Prior Art Against the Appealed Claims Because the Effective Reference Date of Tran's Patent is After the Priority Date of the Appealed Claims.

In order for Tran's patent to be prior art against the appealed claims, the Board of Appeals needed to hold that:

1. 35 U.S.C. § 119(e) shifts the effective reference date of Tran's patent to the effective reference date of Tran's provisional, and
2. 35 U.S.C. § 102(e) establishes the effective reference date of Tran's provisional as the filing date of Tran's provisional.

The appellants respectfully submit that both propositions are incorrect. They shall be addressed in turn.

A. The Board of Appeals Erred in Holding That 35 U.S.C. § 119(e) Shifts the Effective Reference Date of a Patent to the Effective Reference Date of the Provisional From Which it Claims Priority.

There are three reasons why a § 119(e) priority claim does not shift the effective reference date of a patent to the effective reference date of the provisional.

First, the plain language of § 119(e) makes it clear that the language of the section only applies to the priority date of claims — and that no shifting of the effective reference date of the non-provisional is intended.

Second, the law shifts the effective reference date for a continuation application to a parent application only because the continuation and the parent have the exact same disclosure. No new matter is permitted in the later document, and, therefore, the parent is, in essence, "the reference."

In contrast, there is no prohibition against adding new matter to a non-provisional that succeeds a provisional. In fact, the new matter in a non-

provisional can be conceived after the filing of the provisional. So if the non-provisional were accorded the effective reference date of the provisional, then the new matter in the non-provisional could be accorded an effective reference date before it was ever conceived.

Third, provisional applications are the domestic analog of foreign patent applications and were added to the United States patent system for the purpose of offering United States citizens priority rights parallel to the foreign priority rights that benefited primarily foreign citizens. 35 U.S.C. § 119(a)-(d) does not shift the effective reference date of a United States patent document to a foreign application, and § 119(e) should not be held to shift the effective reference date of a United States patent document either.

B. The Board of Appeals Erred in Holding That the Effective Reference Date of Tran's Provisional is Governed by § 102(e), and is, Therefore, its Filing Date.

There are three reasons why the effective reference date of a provisional is not its filing date.

First, the plain language of § 102(e) provides two exceptions to § 102(a)/(b) for specific types of patents and printed publications. The first exception is provided by § 102(e)(1), and it applies to United States patent application publications. The second exception is provided by § 102(e)(2), and it applies to United States patents. There is no exception for provisionals.

Second, the reasons why non-provisionals are governed by § 102(e) compel that provisionals should not be within the scope of § 102(e). Justice Holmes in *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926) held that the effective reference date of a patent should be its filing date because:

(1) the inventor had done "all that he could to make his description public," and

(2) the only reason that his disclosure was not prior art earlier is because of administrative delays in the Patent Office.

Clearly, this reasoning does not apply to provisionals. A provisional does not publish. The inventor who files a provisional hasn't made any effort to make his description public, and no amount of effort or efficiency or expediency on the part of the Patent Office can accelerate the date on which a provisional is published.

If Justice Holmes argued that an inventor who has "done all that he could to make his description public" compels that a non-provisional should be prior art on its filing date, then Justice Holmes would surely argue that an inventor who has done nothing to make his description public compels that a provisional should not be prior art on its filing date.

Therefore, the reasons why non-provisionals are within the scope of § 102(e) compel that provisionals should not be within the scope of § 102(e).

Third, the philosophical division between applications governed by § 102(a)/(b) versus § 102(e) is between § 119(a)-(d) foreign applications and their domestic analog (*i.e.*, § 111(b) provisionals) on the one hand versus § 111(a) non-provisionals on the other.

Before the enactment of § 111(b), a foreign applicant who filed overseas and then filed a United States non-provisional claiming priority under § 119(a)-(d) to the foreign application had advantages over a domestic applicant whose first filing was a United States non-provisional.

As a result of the Uruguary Round of the General Agreement on Tariffs and Trade (often called the "GATT"), Congress enacted the Uruguay Round Agreements Act, Pub. L. 103-465. Among other things, the Uruguay Round Agreements Act enacted § 111(b) to provide United States citizens with a mechanism to obtain priority rights that are parallel to the foreign priority rights that benefited primarily foreign citizens. This is why § 111(b) provisionals are the domestic analog of foreign applications and not within the scope of § 102(e).

II. Teoman Does Not Anticipate the Appealed Claims.

Teoman teaches a classic example of caching based on pre-filling, exactly like the example of Major League Baseball teams given in the Statement of the Facts, above. Nowhere does Teoman teach or suggest a resource that is prevented

from being cached until two or more requests for the resource are received, as required by the claims.

ARGUMENT

STANDARD OF REVIEW

The United States Court of Appeals for the Federal Circuit reviews the Board's conclusions of law *de novo* and its findings of fact for clear error. *In re Zurko*, 142 F.3d 1447, 1457 (Fed. Cir. 1998).

I. Tran's Patent is Not Prior Art Against the Appealed Claims Because the Effective Reference Date of Tran's Patent is After the Priority Date of the Appealed Claims.

In order for Tran's patent to be prior art against the appealed claims, the Board of Appeals needed to hold:

1. 35 U.S.C. § 119(e) shifts the effective reference date of Tran's patent to the effective reference date of Tran's provisional, and
2. 35 U.S.C. § 102(e) establishes the effective reference date of Tran's provisional as the filing date of Tran's provisional.

The appellants respectfully submit that both propositions are incorrect. They shall be addressed in turn.

A. The Board of Appeals Erred in Holding That § 119(e) Shifts the Effective Reference Date of a Patent to the Effective Reference Date of the Provisional From Which it Claims Priority.

The "priority date" of a claim and the "effective reference date" of a reference are two distinct concepts, and yet the Board of Appeals failed to recognize the distinction in holding that § 119(e) shifts the effective reference date of a patent to the effective reference date of the provisional from which it claims priority. *In re Hilmer*, 149 USPQ 480 (CCPA 1966) (AKA "*Hilmer* I"); *In re Hilmer*, 165 USPQ 255 (CCPA 1970) (AKA "*Hilmer* II").

Priority Date — Each claim in a patent document is accorded a date called the claim's "priority date." Each reference is accorded a date called the reference's "effective reference date." The purpose of the claim's priority date and the reference's effective reference date is to determine whether the references is prior art against the claim or not.

For example, when the effective reference date of a reference is before the priority date of a claim, the reference is prior art against the claim. In contrast, when the effective reference date of a reference is after the priority date of a claim, then the reference is not prior art against the claim.

Each claim in a patent has its own priority date — and the priority date of one claim is independent of the priority date of another claim. In general, the priority date of a claim is the filing date of the earliest application to which priority

is claimed and in which the claim is "supported" or "disclosed in the manner provided by the first paragraph of section 112" of Title 35.

For example, when a patent does not claim priority to any other applications, the priority date of all of the patent's claims is the filing date of the application.

In contrast, when a "child" application is filed that claims priority to a "parent" application, the claims in the child application that are supported by the parent have as their priority date the filing date of the parent, but the claims that require support from the new matter in the child application have as their priority date the filing date of the child application. § 119(a)-(d) provides this when the parent is a foreign patent application; § 119(e) provides this when the parent is a § 111(b) provisional, and § 120 provides this when the parent is a § 111(a) non-provisional application.

Effective Reference Date — Each reference has an effective reference date. Some references are patent documents that comprise claims that have priority dates. In contrast, some references — like magazine articles — do not have claims. In any case, all references have an effective reference date. The fact that all references have an effective reference date but that only some have claims with priority dates proves that a claim's priority date and a reference's effective reference date are two distinct concepts.

The effective reference date of a patent document can be, but is not necessarily, the same as the priority date of the claims in the patent document. For example, when a United States patent claims priority to a foreign application under § 119(a)-(d), each claim supported by the foreign application has as its priority date the filing date of the foreign application. In contrast, the effective reference date of the patent is not shifted to the filing date of the foreign application, but is its actual filing date. § 102(e), *In re Hilmer*, 149 USPQ 480 (CCPA 1966) (AKA "*Hilmer* I"); *In re Hilmer*, 165 USPQ 255 (CCPA 1970) (AKA "*Hilmer* II").

In some cases, however, both the effective reference date of a patent document and the priority date of the claims in the patent document both shift to the filing date of the priority document. For example, when a "child" continuation application claims priority to a "parent" non-provisional application under § 120, the priority date of the claims in the continuation and the effective reference date of the continuation is the filing date of the parent.

Given this context, the question arises: Does a United States patent's § 119(e) priority claim shift the effective reference date of the patent to the effective reference date of the provisional? The appellants respectfully submit that the answer is no.

1. The Plain Language of § 119(e) is Clear That the Priority Date of a Patent's Claims That Are Supported by a Provisional are Shifted to the Filing Date of the Provisional, But That the Effective Reference Date of the Patent is Not Shifted.

35 U.S.C. § 119(e)(1) reads:

> 35 U.S.C. § 119 Benefit of earlier filing date; right of priority.
>
> * * *
>
> (e)(1) An application for patent filed under section 111(a) or section 363 of this title ***for an invention*** disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, ***as to such invention***, as though filed on the date of the provisional application filed under section 111(b) of this title.
>
> * * *
>
> (***emphasis added***)

The language "***for an invention***" and "***as to such invention***" makes it clear that the language "shall have the same effect, ***as to such invention***, as though filed on the date of the provisional [.]" applies only to the priority date of each claim — and that no shifting of the effective reference date of the non-provisional is intended.

2. The Law Shifts the Effective Reference Date for an Patent to an Earlier Application from Which Priority is Claimed Only When the Patent and the Earlier Application Have the Same Disclosure.

35 U.S.C. § 120 shifts the effective reference date of a continuation application to the effective reference date of the parent because both documents are required by law to have the exact same disclosure. No new matter is permitted in the later document, and, therefore, the parent is, in essence, "the reference."

This is reasonable because there is no chance that subject matter disclosed in the continuation will ever be accorded an effective reference date that is earlier than when is was disclosed or conceived. But this is not analogous to the issue at hand.

There is no prohibition against adding new matter to a non-provisional that succeeds a provisional. In fact, the new matter in a non-provisional can be conceived after the filing of the provisional. So if the non-provisional were accorded the effective reference date of the provisional, then the new matter in the non-provisional could be accorded an effective reference date before it was ever conceived. This is obviously silly.

In an attempt to prevent such a ridiculous outcome from occurring, the Board of Appeals fashioned a procedure that is even more ridiculous. Keep in mind that at this point the Board of Appeals has already held that Tran's provisional is itself prior art against the appealed claims. Therefore, if the Board

of Appeals chose too, it could compare Tran's provisional directly against the appealed claims. But it didn't because Tran's provisional doesn't anticipate the appealed claims. Instead, the Board of Appeals needed to compare Tran's patent against the appealed claims to sustain the rejection.

The procedure that the Board of Appeals fashioned is that Tran's patent would be used against the appealed claims but only for that subject matter that was "supported" by Tran's provisional. This is absurd.

If the Board of Appeals truly wanted to use only that portion of Tran's patent that is "supported" by Tran's provisional against the appealed claims, then it would have used Tran's provisional against the claims. The best evidence of what is supported by Tran's provisional is the Tran provisional itself. The easiest, most accurate, and most straightforward way to limit Tran's patent to that portion supported by Tran's provisional would have been to compare the appealed claims directly with Tran's provisional. Adding Tran's patent into the mix only obscures what Tran's provisional does and does not teach. The Board of Appeals needed that obscurity to sustain the rejection.

Determining the novelty of a claim against one reference can be a difficult task. Determining the novelty of a claim against a second reference, but only after determining which parts of the second reference are "supported" by the first

reference, makes the task unnecessarily difficult and prone to errors. It has no advantages.

Perhaps the Board of Appeals believes that new matter is easily delineated from old matter — as if new matter were simply a new paragraph or a new figure that could be removed with surgical precision.

This might be more common in a non-provisional application that is succeeded by a continuation-in-part, but it is uncommon in a provisional that is succeed by a non-provisional. The differences between a provisional and a non-provisional are often subtle and profound. There are often changes in abstraction, nomenclature, and theories about "what the invention really is." Inventors often draft provisionals; attorneys often draft non-provisionals. Provisionals are often drafted in haste; non-provisionals are (hopefully) drafted with more deliberation. The notion that Tran's patent can be dissected into "supported" and not "supported" portions is specious.

Furthermore, if the Board of Appeals wanted to limit Tran's patent to what was supported by Tran's provisional, it should have redacted those portions of Tran's patent that were not supported by Tran's provisional. Also, the Board of Appeals should have reversed changes in nomenclature, abstraction, and perspective to what was used in the provisional. If it had done these things correctly, it would have re-created Tran's provisional.

Although the Board of Appeals said that it wanted to limit Tran's patent to what was supported by Tran's provisional, it never mentioned what was or was not in Tran's provisional. It never made any effort to identify the new matter in Tran's patent. It never made any effort to identify the supported matter in Tran's patent.

Instead, the Board of Appeals compared Tran's patent to the appealed claims and sustained the rejection. Then it put the burden on the appellants to prove that Tran's provisional did not "support" that portion of Tran's patent relied on to make the rejection.

3. 35 U.S.C. § 119(a)-(d) Does Not Shift the Effective Reference Date of Non-Provisionals and § 119(e) Should Not Either.

Provisional applications were added to the United States patent system for the purpose of offering United States citizens priority rights parallel to the foreign priority rights that benefited primarily foreign citizens. This is described in detail in Section I.B.3 and as summarized in Table 1, below.

35 U.S.C. § 119(a)-(d) does not shift the effective reference date of a United States patent document to a foreign application, and § 119(e) should not be held to shift the effective reference date of a United States patent document either.

Provisional applications are far more analogous to foreign applications than non-provisional applications, and if Congress wanted provisional applications to be treated like § 120 continuations, it would have added them to § 120 and not § 119.

B. The Board of Appeals Erred in Holding That the Effective Reference Date of Tran's Provisional is Governed by § 102(e), and is, Therefore, its Filing Date.

The default effective reference date for a patent and a printed application is provided by § 102(a)/(b) and is the date on which it issues or publishes, respectively.

35 U.S.C. § 102(e) provides two exceptions to § 102(a)/(b), however, for specific types of patents and printed publications. The first exception is provided by § 102(e)(1), and it applies to United States patent application publications. The second exception is provided by § 102(e)(2), and it applies to United States patents.

Section 102(e) provides that the effective reference date of United States patents and United States patent application publications is the filing date of the "application for patent" from which they are granted or published.

1. The Plain Language of 35 U.S.C. § 102(e) Shows That a Provisional is Not Within the Its Scope.

Section 102(e) reads:

> **35 U.S.C. § 102 Conditions for patentability; novelty and loss of right to patent.**
>
> A person shall be entitled to a patent unless —
>
> * * *
>
> (e) the invention was described in — (1) an ***application for patent, published under section 122(b)***, by another filed in the United States before the invention by the applicant for patent or (2) ***a patent granted on an application for patent*** by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language [.]
>
> (***emphasis supplied***)

Section 102(e)(1) provides that the first type of document governed by § 102(e) is an "application for patent, published under section 122(b)." A provisional cannot be considered an "application for patent, published under section 122(b)" because § 122(b)(2)(A)(iii) explicitly provides that a provisional is not published.

Ex Parte Yamaguchi, 88 USPQ2d 1606, 1611 (BPAI 2008) (precedential) argued that a provisional is within the scope of § 102(e)(1) as follows:

1. A non-provisional can be published under section 122 and is "an application for patent, published under section 122."
2. § 111(b)(5) provides that a provisional can be converted into a non-provisional.
3. Therefore, a provisional is "an application for patent, published under section 122."

The appellants respectfully submit that *Yamaguchi's* logic is faulty and its conclusion is backwards. *Yamaguchi's* admission that it is necessary to convert a provisional into a non-provisional in order to be published proves that a provisional is not "an application for patent, published under section 122." If it were, then the conversion would not be necessary.

Section 102(e)(2) provides that the second type of document governed by § 102(e) is "a patent granted on an application for patent." This demands the question: "Can a patent be granted on a provisional?" The answer is no — a patent cannot be granted on a provisional. 35 U.S.C. §§ 111(b)(8) and 131.

35 U.S.C. § 111(b)(8) is controlling and reads:

> **35 U.S.C. § 111 Application.**
> * * *
> (b) PROVISIONAL.—
> * * *
> (8) APPLICABLE PROVISIONS.—The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135, and 157 of this title.

35 U.S.C. § 111(b)(8) begins with a generalization that the provisions of Title 35 relating to "applications for patent" shall apply to "provisional applications." If this generalization were unqualified, then there would be little question that a provisional is within the scope of § 102(e)(2). But the phrase is qualified — twice.

The first qualification — "except as otherwise provided" — neutralizes the generalization that a provisional is within the scope of § 102(e)(2) and compels the plain language of § 102(e)(2) to prevail.

The second qualification — "except that provisionals for patent shall not be subject to sections 115, 131, 135, and 157 of this title" makes explicit what the first qualification merely implied. The second qualification explicitly states that a provisional shall not be subject to § 131 — which provides for the examination of applications and the granting of patents from those applications. 35 U.S.C. § 131 states:

35 U.S.C. § 131 Examination of application.

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

Therefore, the second qualification makes it explicit that a patent cannot be granted on a provisional.

Yamaguchi also concluded that a provisional is, in fact, within the scope of § 102(e)(2). Using a similar pseudo syllogism as used in analyzing § 102(e)(1), *Yamaguchi* argued:

1. A patent can issue from a non-provisional application.
2. 35 U.S.C. § 111(b)(5) provides that a provisional can be converted into a non-provisional.
3. Therefore, a patent can issue from a provisional.

This attempt at deductive reasoning is no more successful than that used in analyzing § 102(e)(1). *Yamaguchi's* admission that it is necessary to convert a provisional into a non-provisional in order to issue proves that a provisional is not "an application for patent" under § 102(e)(2).

When § 122(b) was enacted[1] — which provided for the publication of patent applications — § 102(e) was explicitly amended to make it clear that it applied to

[1] Nov. 29, 1999, Public Law 106-113

published applications. But when § 111(b) was enacted[2] — which provided for provisionals — § 102(e) was not amended even though five[3] other sections of Title 35 were explicitly amended to make it clear that they applied to provisionals. If Congress has intended § 102(e) to apply to provisionals, then it would have been amended accordingly.

In summary, the plain language of 35 U.S.C. §§ 102 and 111 makes it clear that the Board of Appeals erred in holding that a provisional is within the scope of § 102(e).[4]

---

[2] Dec. 8, 1994, Public Law 103-465.

[3] 35 U.S.C. §§ 41, 111, 119, 122, and 154.

[4] This leads to the natural question, "What is the effective reference date of a provisional under 102(a)/(b)?" One commentator has suggested that the effective reference date of a provisional depends on whether or not the provisional is incorporated by reference into a non-provisional.

→ If the provisional is incorporated by reference into a non-provisional, then the subject matter of the provisional is contained within the disclosure of the non-provisional. Therefore, the provisional takes as its effective reference date the effective reference date of the non-provisional. The effective reference date of the non-provisional is governed by section 102(e) and is the filing date of the non-provisional. In summary, if the provisional is incorporated by reference into a non-provisional, then the effective reference date of the provisional is the filing date of the non-provisional.

→ If the provisional is not incorporated by reference into the non-provisional, but is merely bound to the prosecution history of the non-provisional by a priority claim under 35 U.S.C. 119(e), then the effective reference date of the provisional is the effective reference date of the

2. The Reasons Why Non-Provisionals are Governed by § 102(e) Compel That Provisionals Should Not be Governed by § 102(e).

In 1952, the ruling of *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926) was codified as 35 U.S.C. § 102(e). D. Chisum, Chisum on Patents, § 3.07[1] (Rel. 116-12/2008 Pub. 525). Before *Milburn* the effective reference date of a patent was the date on which the patent issued.

When the effective reference date of a patent was its issue date, the problem arose that administrative delays on the part of the Patent Office penalized inventors by delaying the date on which their disclosures became prior art.

The Court in *Milburn* held that the effective reference date of the patent should be the date on which it was filed because, as Justice Holmes wrote:

> prosecution history. The effective reference date of the prosecution history is governed by 102(a)/(b) and is the date on which the prosecution history becomes public (which is the earlier of the publication or issue date of the non-provisional). In summary, if the provisional is not incorporated by reference into the non-provisional, then the effective reference date of the provisional is the earlier of the publication or issue date of the non-provisional.

Every event date in the course of Tran's provisional, Tran's non-provisional, and Tran's patent (except for the filing of Tran's provisional) occurs after the priority date of the pending claims. For example, the filing date of Tran's non-provisional (12/29/2000) and the issue date of Tran's patent (5/2/2006) both occur after the priority date (11/29/2000) of the appealed claims. So whatever date this Court chooses as the 102(a)/(b) effective reference date of Tran's provisional, it is after the priority date of the appealed claims.

> "The delays of the patent office ought not to cut down the effect of what has been done. . . . ***[The inventor] had done all that he could to make his description public. He had taken steps that would make it public as soon as the Patent Office did its work***. . . We see no reason in the words or policy of law for allowing [the inventor's adversary] to profit by the delay[.]"
>
> *Milburn*, 270 U.S.C. § 390 at 401.

In other words, *Milburn* held that the effective reference date of the patent should be its filing date because:

(1) the inventor had done "all that he could to make his description public," and

(2) the only reason that his disclosure was not prior art earlier is because of administrative delays in the Patent Office.

Clearly, this reasoning does not apply to provisionals. A provisional cannot publish. The inventor who files a provisional knows this. No amount of effort or efficiency or expediency on the part of the Patent Office can accelerate the date on which a provisional is published. The inventor knows this too, and, therefore, an inventor who files a provisional hasn't made any effort to make his description public.

If Justice Holmes argued that an inventor who has "done all that he could to make his description public" compels that a non-provisional should be prior art on its filing date, then Justice Holmes would surely argue that an inventor who has

done nothing to make his description public compels that a provisional should not be prior art on its filing date.

The inventor who files a provisional gets a 12-month option to observe and consider the business and technical environment in which his or her patent might issue. If during those 12 months the inventor likes what he or she sees, then the inventor can file a non-provisional application. In contrast, if the inventor does not like what he or she sees, the inventor keeps the invention a trade secret. This is certainly not Justice Holmes's inventor.

For these reasons, the policy and logic that underlie the application of § 102(e) to non-provisional applications make it clear that § 102(e) should not apply to provisionals.

3. Applications Whose Priority is Claimed Under § 119 Are Not Within the Scope of § 102(e).

When a priority claim is made to a foreign application under § 119, the effective reference date of a foreign application is governed by § 102(a)/(b) and not by § 102(e).

In contrast, when a priority claim is made to a United States non-provisional application under § 120, and the effective reference date of a non-provisional is governed by § 102(e) and not by § 102(a)/(b).

In this context, it seems incongruous for the Board of Appeals to hold that a provisional application — whose priority is claimed under § 119 — should have a effective reference date that is governed by § 102(e).

A jingoist might argue that the philosophical division between documents governed by § 102(e) versus § 102(a)/(b) is whether they are United States patent documents or not. Under this rationale, United States provisionals, non-provisionals, and patents are within § 102(e), but foreign applications and patents are within § 102(a)/(b). The unvoiced opinion of the jingoist might be that United States documents are somehow more worthy of being prior art earlier than are foreign documents.

The appellants respectfully submit that the better philosophical division between documents governed by § 102(a)/(b) versus § 102(e) is between § 119(a)-(d) foreign applications and their domestic analog (*i.e.*, § 111(b) provisionals) on the one hand versus § 111(a) non-provisionals on the other.

Before the enactment of § 111(b), a foreign applicant who filed overseas and then filed a United States non-provisional claiming priority under § 119(a)-(d) to the foreign application had advantages over a domestic applicant whose first filing was a United States non-provisional.

For example, the foreign applicant could effectively extend the term of his or her United States patent by one year because the foreign application did not count

against the term of the United States patent, unlike the case of a United States patent that issued from a continuation application. 35 U.S.C. §§ 154(a)(3) & 120

As a result of the Uruguary Round of the General Agreement on Tariffs and Trade (often called the "GATT"), Congress enacted the Uruguay Round Agreements Act, Pub. L. 103-465. Among other things, the Uruguay Round Agreements Act enacted 35 U.S.C. § 111(b) to provide United States citizens with a mechanism to obtain priority rights that are parallel to the foreign priority rights that benefited primarily foreign citizens. P.L. Gardner and I. Kayton, Patent Practice 7th Ed., Patent Resources Institute, Inc., Pg. 7.1, January 2001. The result has been successful.

For example, neither a foreign application nor a provisional affects the term of the United States patent. 35 U.S.C. § 154(a)(3). In contrast, a non-provisional does affect the term of continuation and divisional applications.
35 U.S.C. § 154(a)(2).

Also, the United States Code does not allow priority to be chained through multiple foreign applications or multiple provisionals, but does allow priority to be chained through multiple non-provisionals. 35 U.S.C. §§ 111(b)(7) & 120.

If no priority claim is ever made to a foreign application or a provisional, neither the foreign application or the provisional is prior art as of its filing date. 35 U.S.C. § 122(b)(2)(A)(iii). But if no priority claim is made to a non-provisional, a non-provisional is prior art as of its filing date. 35 U.S.C. § 102(e)

And finally, a non-provisional application that claims priority to foreign application or a provisional application can contain new matter, but a continuation and divisional that claims priority to a parent non-provisional cannot contain new matter. MPEP 201.07, Eighth Ed. Aug. 2001, Revised July 2008.

This is summarized in Table 1.

Priority Application	**Foreign Application**	**Provisional**	**Non-Provisional**
Priority Benefit Accorded By	§ 119 (a)-(d)	§ 119 (e)	§ 120/121
Interval Between Filing Date of Priority Application and Filing Date of § 111(a) Application	Up to 12 months § 119(a)	Up to 12 months § 119(e)(1)	During Pendency of Parent Application § 120
Effect of Priority Application on Term of Issued § 111(a) Patent	Does Not Affect Term § 154(a)(3)	Does Not Affect Term § 154(a)(3)	Affects Term § 154(a)(2)
Without Priority Claim, Can Priority Application Be § 102 Prior Art as of Its Filing Date?	No[5]	No § 122(b)(2)(A)(iii)	Yes § 102(e)
Can Application Claim Priority to Application of Same Type?	No § 119(a)	No § 111(b)(7)	Yes § 120/121
Must Priority Application Disclosure and Non-provisional Disclosure Be Identical	No	No	Yes[6]
Effective Reference Date?	Not Filing Date of Priority Application[7]	**To Be Decided by This Court**	Filing Date of Priority Application §§ 102(e)/ 120

[5] *In re Hilmer*, 149 USPQ 480 (CCPA 1966) (AKA "*Hilmer* I")
[6] MPEP 201.07, Eighth Ed. Aug. 2001, Revised July 2008.
[7] *In re Hilmer*, 149 USPQ 480 (CCPA 1966) (AKA "*Hilmer* I"); *In re Hilmer*, 165 USPQ 255 (CCPA 1970) (AKA "*Hilmer* II")

Table 1 — Comparison of Foreign, Provisional, and Non-Provisionals as Priority Applications under 35 U.S.C. §§ 119, 120, & 121

For these reasons, the appellants respectfully submit that a § 111(b) provisional is not an "application for patent" under § 102(e), and, therefore, that its effective reference date is governed by § 102(a)/(b). If this Court agrees, then the current rejection based on Tran should be reversed.

II. Teoman Does Not Anticipate the Appealed Claims.

Teoman teaches a classic example of caching based on classic prior art pre-filling and post-filling, and the appellants respectfully submit that the Board of Appeals made an error of logic in inferring that Teoman anticipates the appealed claims.

Claim 1 is representative of all of the appealed claims, and recites:

> **1.** A method comprising:
>
> populating a cache with a resource ***only*** when at least *i* requests for said resource have been received;
>
> wherein *i* is an integer and is at least occasionally greater than one.
>
> (*emphasis supplied*)

Nowhere does Teoman teach or suggest the strict conditional limitation that the cache is populated with the resource ***only*** when at least *i* requests for the resource have been received, wherein *i* is — at least occasionally — greater than one. In other words, there are occasions when a resource is prevented from being stored in the cache until two or more requests for the resource are received.

The Board of Appeals wrote:

> Teoman teaches, however, that as part of a user cache manager, "a user may specify that, after a threshold number of files within a directory have been accessed, all the files in the directory are to be preloaded (FF 9).

The appellants agree.

This is classic prior art caching based on pre-filling and post-filling. In Teoman's example, a number of files are associated by being within a directory. When a "threshold number of files within [the] directory have been accessed, all of the files in the directory are to be preloaded." This is identical to the example used to explain pre-filling and post-filling in the Statement of the Facts section, above.

For example, the directory might contain the thirty Web pages of the Major League Baseball teams. Therefore, if the threshold number is two, then two requests — the request for the Baltimore Orioles Web page and the request for the Boston Red Sox Web page — will trigger the storage of all thirty Web pages in the cache — even though no requests for twenty-eight of them have yet been received. The twenty-eight Web pages that were stored in the cache before they are requested are examples of classic prior art pre-filling. Teoman even uses the word "preloaded" to describe what it does.

The Baltimore Orioles Web page is stored in the cache after there has been a request for it. This is classic post-filling. Similarly, the Boston Red Sox Web page

is stored in the cache after there has been a request for it. This is also classic prior art post-filling.

Nowhere does Teoman teach or suggest that a resource is prevented from being stored in the cache until two or more requests for that resource file have been received.

The Board continues:

> Teoman thus teaches populating a cache with a resource (i.e., a directory) when at least i requests for that resource (i.e., files making up that directory) have been received, wherein i is an integer at least occasionally greater than one (because Teoman teaches loading a directory in response to (plural) requests."

The applicants respectfully disagree.

First, notice how the Board of Patent Appeals cheated. First it mapped the Teoman's directory to the first instance of the claim's "resource" and then it re-mapped Teoman's "files making up that directory" to the second instance of the claim's resource. In other words, when the Board of Appeals needed "resource" to mean the collection of all files in the directory, it did so, but when it needed "resource" to mean one or more individual files, it changed what it meant. This shifting of levels of abstraction invalidates its analysis.

If the Board of Appeals believes that the proper level of abstraction is the directory level, the rejection is specious because Teoman fails to teach that there are requests for the "directory." Teoman teaches only requests for individual files.

More importantly, if the proper level of abstraction is the directory level, Teoman fails to teach that there are occasions when the "directory" is prevented from being stored in the cache until two or more requests for the "directory" have arrived.

In contrast, if the Board of Appeals believes that the proper level of abstraction is the file level, then the rejection also fails. Teoman teaches two types of files:

(i) those files in the directory that are cached before they are ever requested, and

(ii) those file in the directory that are cached after they are requested.

The first are pre-filled like the twenty-eight baseball Web pages that are stored in the cache before they are requested, and the second are post-filled like the Baltimore Orioles Web page and the Boston Red Sox Web page, which are stored in the cache after they are requested.

For this reason, the rejection is logically wrong and clearly erroneous.

Second, when the Board of Appeals states that "Teoman teaches loading a directory in response to plural requests," it is erroneously equating the requests of two files —a first file and second file — in order to trigger the caching of a third file to be equivalent to the appealed claim's two requests for one resource in order to trigger the caching of that resource. In other words, it is equating a request for

the Baltimore Orioles Web page and a request for the Boston Red Sox Web page to trigger the caching the Chicago Whitesox Web page to be equivalent to appealed claim's two requests for the Baltimore Orioles Web page to trigger the caching of the Baltimore Orioles Web page.

For this reason, the rejection is logically wrong and clearly erroneous.

For these reasons, the appellants respectfully submit that the holding of the Board of Patent Appeals to sustain the rejection of claim 1 based on Teoman is clearly erroneous and should be reversed.

Because claims 8, 11, 12, 15, 22-24, 27-28, and 31-32 either depend on claim 1 or contain the identical limitation as claim 1, the appellants respectfully submit that the holding of the Board of Patent Appeals in sustaining their rejection should also be reversed.

CONCLUSION

The appellants respectfully request that this Court reverses the rejection of appealed claims 1, 8, 11, 12, 15, 22-24, 27-28, and 31-32, and orders the Director of Patents to allow claims 1, 8, 11, 12, 15, 22-24, 27-28, and 31-32 and pass the application to issue.

Respectfully Submitted,

_____

Jason P. DeMont
Robert L. Greenberg
DeMont & Breyer, LLC
100 Commons Way, Suite 250
Holmdel, New Jersey 07733
(732) 578-0103

ADDENDUM

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,737	11/29/2000	Peter Joseph Giacomini	500-002US	9624

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DEMONT & BREYER, LLC
100 COMMONS WAY, Ste. 250
HOLMDEL, NJ 07733

EXAMINER	
VU, THONG H	

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER JOSEPH GIACOMINI, WALTER MICHAEL PITIO,
HECTOR FRANCISCO RODRIGUEZ, and
DONALD DAVID SHUGARD

Appeal 2009-0139
Application 09/725,737[1]
Technology Center 2600

Decided:[2] April 15, 2009

Before JOHN A. JEFFERY, MARC S. HOFF, and KARL D. EASTHOM, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] The real party in interest is Broadspider Networks, Inc.

[2] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a non-final rejection of claims 1, 2, 8, 9, 11, 12, 15, 16, 22-25, 27, 28, 31, and 32.[3] We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Appellants' invention relates to a technique for efficiently populating a cache with resources (Spec. 2). Embodiments include populating a cache with a resource only when at least *i* requests for the resource have been received, wherein *i* is an integer and is at least occasionally greater than one, wherein *i* varies with e.g. the time of day, the day of the week, the day of the year, the month of the year, the season of the year, or the year itself (Spec. 10). In another embodiment, the value of *i* does not change over time or as a function of circumstance (Spec. 9).

Claim 1 is exemplary:

> 1. A method comprising:
>
> populating a cache with a resource only when at least *i* requests for said resource have been received;
>
> wherein *i* is an integer and is at least occasionally greater than one.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Tran	7,039,683 B1	May 2, 2006 (filed Dec. 29, 2000)

[3] Claims 3-7, 10, 13, 14, 17-21, 26, 29, and 30 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form (Ans. 4). Further, we note that Appellants' statement that claims 1-32 stand rejected and are appealed (Br. 6) is erroneous, as is the Examiner's indication that the status of the claims in the Brief is correct (Ans. 2).

Teoman	6,463,509 B1	Oct. 8, 2002 (filed Jan. 26, 1999)
Chamberlain	6,408,360 B1	Jun. 18, 2002 (filed Jan. 25, 1999)

Claims 2, 9, 16, and 25 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tran.

Claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Chamberlain.

Claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Teoman.

Throughout this decision, we make reference to the Appeal Brief ("Br.," filed May 22, 2007) and the Examiner's Answer ("Ans.," mailed Oct. 17, 2007) for their respective details.

ISSUES

Appellants assert that dependent claim 2, which calls for *i* to be invariant, is not in conflict with independent claim 1, which requires the value of *i* to be an integer "occasionally greater than one" (Br. 13). With respect to the prior art rejections, Appellants argue that Tran does not qualify as prior art under 35 U.S.C. § 102(e) because its filing date postdates the filing date of the instant application (Br. 15), and that Chamberlain and Teoman fail to anticipate the claimed invention because neither teaches populating a cache with a resource only when at least *i* requests for the resource have been received, wherein *i* is an integer and at least occasionally greater than one (Br. 16, 18).

Appellants' arguments present us with the following four issues:

1. Have Appellants shown that the Examiner erred in finding that one of ordinary skill in the art could not make and use the invention of claim 2, in which the value of *i* is invariant, without undue experimentation?

2. Have Appellants shown that the Examiner erred in finding that Tran qualifies as prior art under 35 U.S.C. § 102(e)?

3. Have Appellants shown that the Examiner erred in finding that Chamberlain teaches populating a cache with a resource only when at least *i* requests for that resource have been received, wherein *i* is an integer that is at least occasionally greater than one?

4. Have Appellants shown that the Examiner erred in finding that Teoman teaches populating a cache with a resource only when at least *i* requests for that resource have been received, wherein *i* is an integer that is at least occasionally greater than one?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

The Invention

1. According to Appellants, the invention concerns a technique for efficiently populating a cache with resources (Spec. 2). Embodiments include populating a cache with a resource only when at least *i* requests for the resource have been received, wherein *i* varies with e.g. the time of day, the day of the week, the day of the year, the month of the year, the season of the year, or the year itself (Spec. 10). In another embodiment, the value of *i* does not change (Spec. 9).

2. According to Appellants' Specification, "[i]n some cases, the value of *i* is one, and in other cases the value of *i* is an integer greater than one. In some cases, the value of *i* is invariant (*i.e.*, it does not change over time or as a function of circumstance)" (Spec. 9).

Tran

3. Tran teaches electronic information caching based on an anticipated demand for that information. Anticipating future requests for access to selected information may be based on, for example, past requests for access to the same or related electronic information. Requests for access may be anticipated before, after, or while an access request is made (col. 1, ll. 27-31, 49-52, and 66-67).

4. Tran includes an "anticipating module" that may be designed to determine the rate or number of requests for electronic information, and to electronically flag electronic information as being in high demand by access requesters where the cache value or frequency of requests for the electronic information is high (col. 4, ll. 32-40).

5. Provisional Application No. 60/234,996, from which Tran claims priority under 35 U.S.C. § 119(e), discloses that "[a]nticipating requests for electronic information . . . is generally performed based on one ore [sic] more criteria, e.g., past requests for information . . . ." (p. 3, ll. 20-21).

Chamberlain

6. Chamberlain teaches a caching system and method that allow for the caching of web pages that have dynamic content, using a cacheability analyzer that analyzes responses based on time, content, user identification, and macro hierarchy (Abstract).

7. Chamberlain teaches various applicability tests for determining whether a dynamic web page should be cached, including tests for appropriate browser type and version and tests for the appropriate language (col. 14, ll. 19-26).

Teoman

8. Teoman teaches an apparatus and method for caching data in a storage device of a computer system. Data is preloaded and responsively cached in the user-configurable cache memory based on user preferences (Abstract).

9. Teoman teaches that, as part of a user cache manager, "a user may specify that, after a threshold number of files within a directory have been accessed, all the files in the directory are to be preloaded" (col. 10, ll. 40-43).

PRINCIPLES OF LAW

"'A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference.'" *See In re Buszard*, 504 F.3d 1364, 1366 (Fed. Cir. 2007) (quoting *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994)). Anticipation of a claim requires a finding that the claim at issue reads on a prior art reference. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (citing *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 781 (Fed. Cir. 1985)).

"The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled

with information known in the art without undue experimentation." *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988).

"[A] patent disclosure need not enable information within the knowledge of an ordinarily skilled artisan. Thus, a patentee preferably omits from the disclosure any routine technology that is well known at the time of application." *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1254 (Fed. Cir. 2004).

ANALYSIS

§ 112 REJECTION

Each of claims 2, 9, 16, and 25, rejected as lacking enablement, recites that "the value of *i* is invariant." The Examiner stated that "claim 1 clearly recited *i* is variable by reciting the *i* is occasional [sic] greater than 1. It can't be invariant" (Ans. 3).

We do not find the Examiner's reasoning persuasive. Claim 1 (and all other pending independent claims) recites that "*i* is an integer and is at least occasionally greater than one." The Specification discloses that "[i]n some cases, the value of *i* is one, and in other cases the value of *i* is an integer greater than one. In some cases, the value of *i* is invariant (*i.e.*, it does not change over time or as a function of circumstance)" (FF 2). If *i* is at least occasionally greater than one (as claim 1 requires), it is therefore possible that *i* could be invariant (as claim 2 requires), and always be equal to two, or three, or any other integer greater than one, without doing violence to the requirement of claim 1. We find, therefore, that Appellant's Specification discloses the invention of claim 2 such that one of ordinary skill in the art could make and use it without undue experimentation.

Because Appellants have shown error in the Examiner's rejection of claims 2, 9, 16, and 25 under 35 U.S.C. § 112, first paragraph, we will not sustain the rejection.

§ 102 REJECTION OVER TRAN

We select claim 1 as representative of this group, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii).

Appellants argue that Tran does not qualify as prior art because "[t]he 102(e) filing date of Tran is 29 December 2000, which is after the filing date of the present application (29 November 2000)" (Br. 15).

The Examiner correctly points out, however, that Tran claims domestic priority under 35 U.S.C. § 119(e) from a provisional application[4] filed 25 September 2000, which is prior to the filing date of the present application (Ans. 10). Tran therefore does qualify as prior art, based on the filing date of the provisional application. Appellants make no argument in the Brief that the provisional application does not support the subject matter relied upon to make the § 102(e) rejection in compliance with § 112, first paragraph. *See Ex parte Yamaguchi*, 88 USPQ2d 1606 (BPAI 2008) (precedential). Appellants have therefore failed to carry their burden of establishing that the Examiner erred in applying Tran against the claimed invention.

Tran teaches electronic information caching including an "anticipating module" that may be designed to determine the rate or number of requests [plural] for electronic information, and to electronically flag electronic information as being in high demand by access requesters where the cache

[4] Provisional Application No. 60/234,996 (hereinafter "The Provisional Application").

value or frequency of requests for the electronic information is high (FF 4). Tran thus teaches populating its cache with the "electronic information" when at least *i* requests for that information have been received, wherein *i* is an integer at least occasionally greater than one (i.e., Tran caches electronic information that has been subject to *plural* "requests"). The Provisional Application supports this subject matter, noting that "[a]nticipating requests for electronic information . . . is generally performed based on one ore [sic] more criteria, e.g., past *requests* for information . . . ." (FF 5 (emphasis added)).

Therefore, because Appellants have not established error in the Examiner's rejection, we will sustain the Examiner's rejection of claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 under 35 U.S.C. § 102.

§ 102 REJECTION OVER CHAMBERLAIN

The Examiner finds that Chamberlain teaches populating a cache with a resource only when at least *i* requests for the resource have been received, wherein *i* is an integer and at least occasionally greater than one (Ans. 5), as is recited in each of independent claims 1, 8, 15, and 24. The section of Chamberlain (FF 7) cited by the Examiner, however, generally describes tests that may be run against a cached response to ensure that it is applicable to the request or the requesting user (*id.*), but does not teach populating a cache with a resource after *i* requests for the resource, *i* being an integer at least occasionally greater than one. While it is possible that one of such tests *could* be whether a web page has been requested at least *i* times, *i* being an integer at least occasionally greater than one, it would be speculation to assert that exactly such a test is performed in Chamberlain's invention. Likewise, we do not find any other disclosure in Chamberlain to the effect

that Chamberlain populates a cache with a resource in response to at least *i* requests for said resource, wherein *i* is at least occasionally greater than one. As a result, we find that Chamberlain does not teach all of the elements of claim 1.

Appellants have thus established error in the Examiner's rejection, and we will not sustain the § 102 rejection of claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 as being anticipated by Chamberlain.

§ 102 REJECTION OVER TEOMAN

We select claim 1 as representative of this group, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii).

Appellants argue that the Examiner erred in rejecting claim 1 as being anticipated by Teoman because Teoman does not teach delaying the population of a cache with a resource until at least *i* requests for the resource have been received, wherein *i* is at least occasionally greater than one (Br. 18).

Teoman teaches, however, that as part of a user cache manager, "a user may specify that, after a threshold number of files within a directory have been accessed, all the files in the directory are to be preloaded" (FF 9). Teoman thus teaches populating a cache with a resource (i.e., a directory) when at least *i* requests for that resource (i.e., files making up that directory) have been received, wherein *i* is an integer at least occasionally greater than one (because Teoman teaches loading a directory in response to (plural) "requests," Teoman teaches at minimum a situation where *i* is always equal to 2 [or more], which is at least occasionally greater than one).

We therefore find that Appellants have failed to establish error in the Examiner's § 102 rejection of claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 as being anticipated by Chamberlain, and we will sustain the rejection.

CONCLUSIONS OF LAW

1. Appellants have shown that the Examiner erred in finding that one of ordinary skill in the art could not make and use the invention of claim 2, in which the value of *i* is invariant, without undue experimentation.

2. Appellants have not shown that the Examiner erred in finding that Tran qualifies as prior art under 35 U.S.C. § 102(e).

3. Appellants have shown that the Examiner erred in finding that Chamberlain teaches populating a cache with a resource only when at least *i* requests for that resource have been received, wherein *i* is an integer that is at least occasionally greater than one.

4. Appellants have not shown that the Examiner erred in finding that Teoman teaches populating a cache with a resource only when at least *i* requests for that resource have been received, wherein *i* is an integer that is at least occasionally greater than one.

ORDER

The Examiner's rejection of claims 2, 9, 16, and 25 under 35 U.S.C. § 112 is reversed. The Examiner's rejection of claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 under 35 U.S.C. § 102 as anticipated by Tran is affirmed. The Examiner's rejection of claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 under 35 U.S.C. § 102 as anticipated by Chamberlain is reversed. The

Examiner's rejection of claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 under 35 U.S.C. § 102 as anticipated by Teoman is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

babc

DEMONT & BREYER, LLC
100 COMMONS WAY, Ste. 250
HOLMDEL NJ 07733